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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,542	12/28/2001	Loris Giuseppe Navoni	32079-00083 USPX	4704

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EXAMINER

LAO, SUE X

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,542

Applicant(s)

NAVONI ET AL.

Examiner

Sue Lao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/02, 9/3/02</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-5 are presented for examination.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "the available expansion" in line 8. There is insufficient antecedent basis for this limitation in the claim. For the purpose of art rejection, it is interpreted as "an available expansion", as best understood and as it appears to be.

Claim 2 recites "the required modes" and "the available expansion" in line 5. There is insufficient antecedent basis for each of these limitations in the claim.

Claim 3 recites "the components", "the "vocabulary of functions"", "the sets", "the other applications", "the supplementary module" in lines 2-4 and "the vocabulary entered" in line 5. There is insufficient antecedent basis for each of these limitations in the claim.

Claim 3 recites "once a given application is selected, finding the components of the "vocabulary of functions" from the sets that pertain to the other applications involved in the expansion made possible by the supplementary module", which is confusing.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al (U S Pat. 6,192,255) in view of Tachibana et al (U S Pat. 6,055,595).

As to claim 1, Lewis teaches a method of expanding the functional capabilities of portable electronic host devices (multiple purpose communication device 50) with user-friendly modes, wherein a host device (50) has a quick-connect functional expansion module (application modules 100, col. 14, lines 43-48) associated therewith, comprising:

on first installation of the given module in the host device, performing a series of checking operations automatically (authentication, col. 16, line 52 – col. 17, line 20);

the user of the host device selecting to activate the available expansion (via display 60 or voice command, col. 16, lines 21-39; col. 19, lines 58-65).

While recognizing each other is necessary for the expansion module to work with the host device, Lewis does not explicitly teach at each installation of a given module, the module and the host device recognizing each other. Lewis does not teach upon a given application being selected, storing the configuration and functions required for each application.

Tachibana teaches a method of expanding the functional capabilities of portable electronic host devices (portable information apparatus, fig. 1, 2) with user-friendly

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modes, wherein a host device (computer, fig. 2) has a quick-connect functional expansion module (PC card 171) associated therewith, comprising:

at each installation of a given module (PC card 171), the module and the host device recognizing each other (recognize insertion, col. 6, lines 27-37); and

upon a given application being selected, storing the configuration and functions required for each application (set card/program registration information to registry 32).

Therefore, it would have been obvious to include the steps of recognizing and storing into Lewis. One of ordinary skill in the art would have been motivated to combine the teachings of Lewis and Tachibana. Lewis teaches multiple expansion modules may be installed to offer a wide range of functions (col. 9, lines 1-18). One of ordinary skill in the art would recognize that managing configurations under such situations increases user's burden. Tachibana teaches a mechanism (registry, fig. 7) to manage configuration information (card/program registration information, col. 7, line 66 – col. 8, line 8) desirable under such situations to reduce the user's burden (col. 1, lines 40-67). Therefore, one of ordinary skill in the art would have been motivated to use the mechanism as taught by Tachibana to manage the configuration information in Lewis.

As to claim 2, Lewis as modified by Tachibana teaches listing the applications installed in the host device (Card aid screens); checking said expansion for compatibility with each application [inherent/necessary to the programs in the list of to function]; searching out the required modes to implement the expansion (list of programs/options), for each application or the first time that an application is called to work; and constructing a "vocabulary" of correspondence between the minimum of functions afforded by the expansion module and the minimum of functions demanded by the application in the host device (Tachibana, set card/program registration information, col. 7, line 66 – col. 9, line 37; fig.s 7-9).

As to claim 3, Lewis as modified by Tachibana teaches once a given application is selected, finding the components of the "vocabulary of functions" from the sets that pertain to the other applications involved in the expansion made possible by the supplementary module (Tachibana, fig. 11, 12); optionally requesting training or verifying the vocabulary entered (compare, Tachibana, fig.12); warning the user of the

availability of the expansion (list available cards); and activating the expansion on request by the user (see discussion of claim 1).

As to claim 4, Lewis as modified by Tachibana teaches storing the configuration, the "vocabularies of functions" for every application (Tachibana, card/program registration information, fig. 7; col. 7, line 66 – col. 8, line 8), and the current state of each activated application (Tachibana, fig. 8A).

As to claim 5, Lewis as modified by Tachibana teaches a system, comprising:

a portable electronic host device with expanded function capability (Lewis, multiple purpose communication device 50); and

a quick-connect function-expanding module, comprising: a host device loading and connecting program (Lewis, utility program, col. 3, lines 23-27); an expansion module control program (Tachibana, Card Aid / utility program, col. 5, line 65 – col. 6, line 21); and an API for the module to dialog with the operating system of the host device (Tachibana, WM_devicechange(), col. 5, line 65 – col. 6, line 21);

wherein the host device includes tables of correspondence (card/program registration information, col. 7, line 66 – col. 8, line 8) between the applications and the commands of the installed module (card configuration screens, fig.s 7-9) and an operating system path for detaining the functions to be expanded (execution program path, fig. 9D, 10C). Note discussion of claim 1 for a motivation to combine.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Lao whose telephone number is (571) 272-3764. A voice mail service is also available at this number. The examiner's supervisor, SPE Meng-Ai An, can be reached on (571) 272 3756. The examiner can normally be reached on Monday - Friday, from 9AM to 5PM. The fax phone number for the organization where this application or proceeding is assigned is (703) 872 9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 18, 2005



SUE LAO
PRIMARY EXAMINER